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AF 2176

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Comer, et al. Examiner: Feild, J.
Serial No.: 09/728,000 Group Art Unit: 2176
Filed: December 1, 2000 Docket: MS39124.2/40062.117USRE
Confirmation No.: 2267 Customer No.: 27488

Title: METHOD AND APPARATUS FOR SUGGESTING COMPLETIONS FOR A PARTIALLY ENTERED DATA ITEM BASED ON PREVIOUSLY-ENTERED, ASSOCIATED DATA ITEMS

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By: *Charlene Huffman*
Name: Charlene Huffman

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PATENT #
5328

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Pursuant to 37 C.F.R. § 1.193(b), this reply brief is presented in response to the Examiner's Answer mailed June 16, 2003. The current appeal relates to the Final Rejection of claims 1-60 in the above identified reissue application due to an alleged violation of the recapture rule.

The Reply Brief is filed in triplicate. No fee is believed to be required for the submission of the present Reply Brief. However, please charge any additional fees to Merchant & Gould P.C., Deposit Account No. 13-2725.

I. The Examiner's Answer Continues to Misinterpret the Law of Recapture

The Examiner's Answer accurately summarizes the arguments made by both the Applicant and the Examiner leading up to the present appeal. However, it is compelling that the Examiner's Answer fails to distinguish or dispute the legal citations in Applicant's Opening Brief regarding the law of "recapture." Specifically, the current dispute is fairly characterized by the Examiner's response to the legal citations at pages 7-8 of the Answer where the Examiner notes that he "again maintains that the patented claims were passed to issue based on the amendments and the original prosecuting attorney's arguments." While Applicant does not disagree with that summary of the file history of the parent application, it simply does not follow that allowance of the claims following an amendment prohibits the Applicant from further amending the claim in a broadening reissue.

The recapture rule only applies if an applicant is attempting to recapture the original scope of the rejected claim (which the Applicant here in **not** attempting to do as explained in the prior briefing). In particular, the Examiner's position on the recapture rejection, which is based solely on the fact that the amendments in the parent application were added to obtain allowance of the claims, is directly at odds with the authority cited in Applicant's Opening Brief. Specifically, in discussing the "recapture" doctrine, Professor Chisum has explained that "a patentee may obtain on reissue a claim that varies materially from the claim originally surrendered even though it omits a limitation intentionally added to obtain issuance of the patent." (4 Chisum on Patents, § 15.03[2][e] at 74-75.) (Emphasis added.)

Furthermore, the Federal Circuit has established a bright line test regarding the applicability of the recapture rule. See Whittaker Corp. v. UNR Industries Inc., 15 U.S.P.Q.2d 1742, 1745 (Fed. Cir. 1990) ("Since we hold that the claims of the reissue patent are narrower in scope than the cancelled original claims of the application that resulted in the '882 patent, the '453 [reissue] patent cannot be held invalid under the recapture rule"). This rule unquestionably prevents the application of the recapture rule in this case since the new reissue claims are narrower than the original claims of the parent application, as described in detail in Applicant's Opening Brief.

Although the Examiner's Answer acknowledges the above citations, the Examiner simply ignores this controlling authority when he continues to argue that impermissible recapture exists

since “Appellant has introduced claim limitations that are broader in an aspect that is germane to a prior art rejection.” (Examiner’s Answer at 7.) Simply put, the Examiner is looking at the wrong claims -- the Examiner should be comparing the new reissue claims to the original claims of the parent application rather than the amended (issued) claims. Thus, as noted above, it is irrelevant that the broadening aspect of the present reissue application relates to a claim limitation that was “germane to a prior art rejection,” provided that the reissue claim is still narrower in all respects than the original claim. Indeed, as noted in the above Chisum quote, the reissue claims can omit a limitation intentionally added to obtain issuance of the patent (which is precisely what the Examiner is alleging occurred in the present case), provided that the reissue claims do not recapture the **original scope** of the rejected claim.

Thus, there is no real dispute regarding the facts of the present appeal, rather the dispute continues to center around the legal import of the acknowledged facts. Unfortunately, the Examiner’s Answer continues to misapply or simply ignore the controlling law relating to the recapture doctrine, and the Examiner does not provide any meaningful response to the legal citations found in Applicant’s Opening Brief. Reversal of the “recapture” rejections of claims 1-60 is therefore respectfully requested.

II. The Examiner’s Answer Raises An Issue that Is Not Relevant to the Present Appeal

The Examiner’s Answer discusses a new portion of the file history of the parent application that has not been addressed in either the prior Office Actions related to the present reissue application or in Applicant’s Opening Brief. Specifically, page 6 of the Examiner’s Answer addresses remarks from the parent file history related to the “Novell” reference. As acknowledged by the Examiner in the portion of the file history excerpted in the Answer, the Novell reference does not relate to the claimed “AutoComplete” feature of the present reissue application. Rather, it relates to a completely different invention (often referred to as “AutoFill”) whereby a spreadsheet user can enter one or more seed values in a cell and then expand the cell to create a well known series. For example, a user could type “January” into a cell and then expand the cell into the next eleven blank cells to fill those cells with the names of the remaining months (i.e., “February” through “December”). However, as noted in the original file history (Examiner’s Answer at 6), this AutoFill feature does not suggest “fill information” based on a

list of completed data items in a search region of the spreadsheet, and thus the Novell reference was easily distinguished from the claims of the parent application. The fact that the original prosecuting attorney referenced the amended claims when discussing the clear distinction from the Novell reference is of no import to the present appeal. Rather, as acknowledged by the Examiner, it was the Smith reference that was purposefully distinguished by the original claim amendments adding the step of “identifying a search region.” (Examiner’s Answer at 4-6.)

Thus, the discussion of the Novell reference in the Examiner’s Answer raises no new issues. Indeed, as described above, the underlying facts are not in dispute and it is only the Examiner’s inappropriate application of the “recapture” doctrine to those facts that must be addressed.

III. Conclusion

It is earnestly solicited that the Examiner and/or the Board carefully reconsider the pending recapture rejections in light of the established law on recapture, particularly since the Examiner has agreed that the new reissue claims are patentable over the same Smith reference that led to the claim amendments in the parent case. Specifically, how can the new reissue claims violate the “recapture” doctrine when they include a limitation to a “search region” similar to that added in the parent case to distinguish the Smith reference? The simple answer is that there can be **no violation** of the recapture rule when the reissue claims include limitations not found in the original (canceled) claims of the parent application, particularly when the limitations are similar to those added to the original issued claims and are sufficient to distinguish the reissue claims over the prior art references relied on in the parent application.

In light of the above discussion, it is apparent that the new reissue claims do not violate the “recapture” rule, and thus the current statement of error provides a proper basis for reissue. Reversal of the Examiner’s rejections of claims 1-60 is therefore respectfully requested.

In light of the straightforward issues in this appeal, Applicant does not request an oral argument.

Date: August 11, 2003

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